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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,763	03/08/2000	Stephen W. Comiskey	53326.000008	1661

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EXAMINER

CHARLES, DEBRA F

ART UNIT PAPER NUMBER

3628

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/520,763

Applicant(s)

COMISKEY ET AL.

Examiner

Debra F. Charles

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 58-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Claims 58-75 have been reviewed.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-57 have been cancelled. Claims 58-75 have been added.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not address technology as related to or as an integral part of business process.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 58-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killeen, Jr. et al. (US 6324523 B1) and SchwabLife webpage, copyright year 2000.

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Killeen, Jr. et al. disclose a system for providing personalized financial services to a client, the system comprising:

a depository for receiving client data from the client comprising at least one client goal and a client portfolio (Killeen, Jr. et al., Abstract, col. 1, lines 1-40, Fig. 1, col. 2, lines 30-47, col. 3, lines 5-20 and lines 55-67, col. 4, lines 30-35, i.e. "the present invention relates to the systems, database structures, and controlling data processing logic for coordinating a plurality of accounts directed to financial instruments and investments to enhance client resource access and utilization" and "individual investors can establish goals and needs for future capital and income");

a server for assessing the client portfolio based at least in part on the client goal and assigning a plurality of services to a plurality of service provider groups (Killeen, Jr. et al., Abstract, col. 1, lines 1-10, Fig. 1, col. 1, lines 55-67, col. 2, lines 15-32, col. 3, lines 35-67, col. 4, lines 20-67, Cols. 5 and 6, Table 1, col. 7, lines 14-60, col. 8, lines 1-15 col. 11, lines 9-53, and claim 1, i.e. "data processing system that operates to manage a plurality of separate account groups formed by linking together related accounts for brokerage and other financial services and coordinates a variety of services" and "Planning Services" in Table 1, first row, "Retirement Builder, College Builder"),

wherein whether each service is needed by the client on a frequent basis is determined or whether a level of value to the client is above a predetermined level is determined (Killeen, Jr. et al., Abstract, col. 4, lines 54-67, claim 1 and Table 1, i.e. "Service Level, Bronze, Silver, Gold, Platinum, Platinum Plus");

wherein the plurality of services are categorized into a core service provider group, (Killeen, Jr. et al., Abstract, col. 1, lines 1-10, Fig. 1, col. 1, lines 55-67, col. 2, lines 15-32, col. 3, lines 35-67, col. 4, lines 20-67, Cols. 5 and 6, Table 1, col. 7, lines 14-60, col. 8, lines 1-15 col. 11, lines 9-53, and claim 1, i.e. "each account in the account group is set up with an initial set of attributes") an affiliated service provider group and a . . . . based at least in part on the steps of determining(Killeen, Jr. et al., Abstract, col. 2, lines 40-45, i.e. "account database structures include flags which inform the other service providers of the fee structure associated with account transactions") ; and a display for providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data(Killeen, Jr. et al., Abstract, col. 1, lines 1-67, Fig. 1, col. 2, lines 15-32, col. 4, lines 1-6 and claim 1, "use of a network allows PC access either with standard GUI front end or user selected front end").

Re claims 58,63,66 and 71, Killeen, Jr. et al. does not explicitly disclose the non-affiliated service provider group or that this group represents services least common to the client or providing small value to the client. However, Charles Schwab & Co. disclose the non-affiliated service provider group for its life insurance policies underwritten and issued by Great-West Life & Annuity Insurance Company(SchwabLife webpage, copyright year 2000, "Smart financial planning for the future protected . . . your plan includes life insurance"). Thus, it would be obvious to one of ordinary skill in the art to employ a non-affiliated service provider group to supply investment products the primary provider group does not offer.

Re claims 59 and 67, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claims 58 and 66. Killeen, Jr. et al. further disclose wherein the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service (Killeen, Jr. et al., Abstract, col. 4, lines 20-67, Cols. 5 and 6, Table 1, col. 7, lines 14-60, col. 8, lines 1-15 col. 11, lines 9-53, claim 1 and Table 1, i.e. "Service Level, Bonze, Silver, Gold, Platinum, Platinum Plus").

Re claims 60 and 68, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claims 59 and 67 as stated supra and in view of Killeen, Jr. et al., the claimed provider group represents services needed by the client on an infrequent basis or having a level of value below the predetermined level indicating a secondary level of service would have been obvious(Killeen, Jr. et al., Abstract, col. 4, lines 20-67, Cols. 5 and 6, Table 1, col. 7, lines 14-60, col. 8, lines 1-15, col. 11, lines 9-53, claim 1 and Table 1, i.e. "Service Level, Bonze, Silver, Gold, Platinum, Platinum Plus").

Re claims 61 and 69, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claims 60 and 68. Killeen, Jr. et al. further disclose wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an intermediary level of service(Killeen, Jr. et al., Abstract, col. 4, lines 20-67, Cols. 5 and 6, Table 1, col. 7, lines 14-60, col. 11, lines 9-53, claim 1 and Table 1, i.e. "Service Level, Bonze, Silver, Gold, Platinum, Platinum Plus").

Re claims 62 and 70, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claims 58 and 66. Killeen, Jr. et al. further disclose wherein the core service provider group represents services most common to the client or providing most value to the client(Killeen, Jr. et al., Abstract, col. 8, lines 1-16, claim 1 and Table 1, i.e. "Service Level, Bonze, Silver, Gold, Platinum, Platinum Plus").

Re claims 64 and 72, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claims 58 and 66. Killeen, Jr. et al. further disclose wherein services from the core service provider group are presented to the client at a predetermined time; wherein services from the affiliated service provider group and services from the non-affiliated service provider group are presented after the services from the core service provider group are first presented.

Killeen, Jr. et al. does not explicitly disclose the core service provider group is presented to the client at a predetermined time and services from affiliated and non-affiliated service provider group are presented after the services from the core service provider group are first presented. However, Killeen, Jr. et al. disclose in Abstract, col. 10, lines 39-67, col. 11, lines 9-53, claim 1 and Table 1, "Service Level, Bonze, Silver, Gold, Platinum, Platinum Plus" and "periodically updating these account parameters in accordance with pre-established plan criteria". Thus, it would have been within the level of ordinary skill in the art to present services to the client from the core service provider group first and, then, if the core service provider group lacks certain financial products the client wants, then the system will present financial products from affiliates and non-affiliated providers.

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Re claims 65 and 73, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claims 58 and 66. Killeen, Jr. et al. further disclose wherein the services comprise a plurality of asset allocation services(Killeen, Jr. et al., Abstract, col. 1, lines 20-40, i.e. comprehensive asset allocation strategy); investment management services; investment banking services; banking services; custody services; reporting services; tax advice services; filing of federal, state and local tax statement services; estate planning services; legal services; accounting services; bookkeeping services; record keeping services; financial investment services; managing financial assets services; management and other services related to closely held stock services; international trusts services; real estate service; public relations services; crisis management services; selection and delivery of insurance services; physical security services; personal security services; information security services; lease, purchase or fractional ownership of automobiles, planes, vehicles or yachts services; personal concierge services; bill paying services; coordination and direction of charitable activities services; background checks on personal staff or other parties services; offering of investment opportunities not available to non-clients services; development and execution of debt reduction strategies services; development and maintenance of education funds services; advice and care of minors, invalids, elderly, incompetents or other persons services; business succession planning services; issuance of loans, traveler's checks, foreign currency, credit or other banking services(Killeen, Jr. et al., Abstract, col. 1, lines 55-67, cols. 5 and 6, lines 64-67, Table 1, col. 9, lines 8-35, i.e. "a plurality of financial services").



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Re claim 74, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claim 66. Killeen, Jr. et al. further disclose further comprising one or more of a tool for mining data and a synthetic logic tool for assessing the client portfolio(Killeen, Jr. et al., Abstract, cols. 5 and 6, Table 1, i.e. "evaluation tools").

Re claim 75, Killeen, Jr. et al. and SchwabLife webpage disclose the system of claim 74. Killeen, Jr. et al. further disclose wherein the synthetic logic tool converts data into useful information related to the at least one client goal(Killeen, Jr. et al., Abstract, col. 1, lines 30-40, cols. 5 and 6, Table 1, i.e. "evaluation tools").

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grant et al., Banking/Brokerage Computer Interface System.

Musmanno, Securities Brokerage-Cash Management System.

Wallman, Method and Apparatus for Enabling Small Investors with a Portfolio of Securities to Manage Taxable Events within the Portfolio.

Wallman, Method and System for Enabling Smaller Investors to Manage Risk in a Self-Managed Portfolio of Assets/Liabilities.

Wallman, Method and System for Investing in a Group of Investments That are Selected Based on the Aggregated, Individual Preference of Plural Investors.

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WO 01/90997 A2, Wallman, Steven M. H., Method and Apparatus for Analyzing Individual and Comparative Returns on Assets.

Warkenthien, Kristina. Mellon Creates Ultra Family Office Division, Private Asset Management, New York, March 6, 2000.

PNC Advisors to use First Rate Performance to Track After-Tax and Net-of-Fees Performance, Business Wire, New York, March 6, 2000.

Deutsche Asset Management Announces Joint Development Project with Professor Andrew Lo and AlphaSimplex Group, LLC, PR Newswire, New York, March 6, 2000.

Canniffe, Mary, Banks roll out red carpet for wealthy private clients, Irish Times, Dublin, March 3, 2000.

Weitzman, Jennifer, Citi Private Bank to Customize Service on Web, American Banker, New York, NY, March 2, 2000.

Baker, Gill, Japan Sony's got yen for Web banking, Bank Technology News, New York, NY, March 2000.

Burke, Jeanne, Cashing in on Wealth Management, Bank Investment Marketing, Feb 2000, Vol. 8, Issue 2, p.26.

Merrill Lynch webpage copyright year 1999 and year 2000.

Schwab webpage, copyright year 2000.

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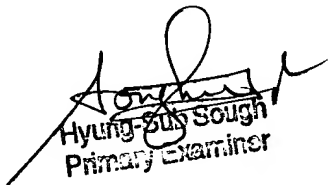
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Debra F. Charles  
Examiner  
Art Unit 3628

dfc  
December 24, 2002

  
Hyung-Sung Sough  
Primary Examiner